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|-----------------|-------------|----------------------|---------------------|------------------|
| 09/845,280      | 04/30/2001  | Frank Thomas         |                     | 3073             |

7590

03/19/2004

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

16

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/845,280

Applicant(s)

THOMAS, FRANK

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-25 is/are allowed.
- 6) ☒ Claim(s) 1-4, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 02/17/2004 –  
Request for Continued Examination (RCE) and Amendment A.

Claims 1-27 are pending.

Following is an action on the MERITS:

Claims 1-4 STAND rejected based upon the Board of Patent Appeals and Interference decision, mailed 08/15/2003. In addition to the *res judicata* effect of the Board decision in an application, a Board decision in an application is the “**law of the case**”, and is thus considered controlling in this related application. See MPEP §706.07(h) (XI)(A) and MPEP §706.03(w).

Claims 5-25 are allowable over the prior art references of record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reach in view of JP Patent No. 405329233 (Applicant Seisaku; Inventor Shoichi Tateishi). At the outset, it is noted that, as was the case during earlier prosecution of this application (prior to the filing of an RCE), the JP Patent noted in this rejection will simply be referred to as “Seisaku”. Reach shows the invention substantially as claimed and includes an alignment means extending along a portion of the top surface of the head and continuing along onto the hosel segment. The alignment means is in the form

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of a line that is generally parallel to a plane containing the striking face. Reach, however, does not show a portion of the line extending on the surface of the shaft, whereby a portion of the line extending along a surface of the head and a portion of the line extending along a surface of the shaft are disposed in a common plane with respect to the longitudinal axis of the shaft and parallel to a plane containing the striking face. The Japanese reference to Seisaku shows it to be old in the art to include an alignment means in the form of a line-shaped piece of tape along the shaft in a direction that is parallel to the face of the putter. In both Reach and Seisaku, the intent is to provide a golfer standing at address with the ability to more readily align the striking face with a ball and the target. In essence, the tape in the Seisaku device is aligned in a perpendicular fashion with respect to an imaginary line that extends to a target point on the green. Thus, the face in the Seisaku device is naturally also aligned in a perpendicular fashion with respect to the same imaginary line. This is clearly evident from Figures 1 and 8 in Seisaku. Taken as a whole, the references to Reach and Seisaku collectively teach that an alignment means such as a line may be placed along a path parallel to the plane of the striking face to help a player orient the club at address. It would appear that alignment is facilitated by a line on either a combination of the head and hosel segments of the head or on the shaft itself. Clearly, placing the alignment means on both the head and the shaft merely enhances the alignment effect. Either design for the line would appear to equally provide an appropriate visual alignment tool which a golfer may use to properly place the putter head with respect to a golf ball at address. In view of the patent to Seisaku and the above reasoning, it would

have been obvious to modify the device in the cited reference to Reach by extending the line (c) along the shaft (b), the motivation being to simply enhance the effect of the alignment means. Specific to claim 27, Seisaku clearly obviates the use of a flat striking face in a vertical plane. Again, see Figures 2 and 8 in Seisaku.

#### RESPONSE TO ARGUMENTS

In the arguments received 02/17/2004, the applicant sets forth arguments pertaining to the prior rejection of claim 1-4 and states that new claims 26 and 27 further define the applicant's invention.

In response to these arguments and with respect to the applicant's remarks directed to claims 1-4, no further rebuttal will be presented, here. As stated above, claims 1-4 were the subject of a decision from the Board of Patent Appeals and Interference. Absolutely no further discussion on this matter will be advanced.

With respect to new claims 26 and 27, see the rejection set forth, supra. No further explanation is deemed necessary.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
March 18, 2004